

REMARKS

Claims 4, 6,-13 and 24-34 are all the claims pending in the application. Claims 9, 24-31 and 33 are allowed. Claims 4, 6-8, 10, 32 and 34 are rejected and claims 11-13 are objected to.

Claims 4, 6, 7 and 8 are rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite and unclear. Specifically, the Examiner states that Claims 4, 6, 7 and 8 recite the limitation “according to Claim 3,” and there is insufficient antecedent basis for this limitation because claim 3 has been cancelled.

Claims 4, and 6-8 are amended herein to depend from claim 30, thereby obviating the rejection. Accordingly, Applicants respectfully request withdrawal of the rejection.

Claim 10 is rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. The Examiner states that the new independent Claim 10 does not provide a clear definition or representation of the general formula which is referenced by “allyl-type ester.”

Applicants have amended claim 10 herein by replacing “allyl-type ester” with “unsaturated group-containing ester”. Claim 10 is also amended to include the recited unsaturated group-containing ester, which is denoted as formula (3). Formula (3) is supported in original claim 10 by the expression “formula (1) (n=1)”. Hence no new issues or issues of new matter are presented.

Accordingly, Applicants respectfully request withdrawal of the rejection.

Claims 32 and 34 are rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. The Examiner states that Claims 32 and 34 recite the broad recitation “catalyst which contains at least one metal selected from the group consisting of Group VII elements, Group IX elements and Group X elements” and that the claims contain a narrower statement of

Amendment Under 37 C.F.R. § 1.116
U.S. Application No. 09/582,495

the range/ limitation by the recitation, “catalyst ... is at least one of the species selected from the Group consisting of palladium ruthenium and rhodium.”

Applicants respectfully traverse the rejection and submit that one of ordinary skill in the art would understand from the plain language of the claims that claims 32 and 34 further limit the element of “the hydrogenated catalyst selected from at least one metal selected from the group consisting of Group VIII elements, Group IX elements, and Group X elements in the periodic table” recited in claims 31 and 33. However, to more clearly define the invention and to facilitate and expedite examination, Applicants have amended claims 32 and 34 to read, “wherein the hydrogenating catalyst comprises at least one species selected from the group consisting of palladium, ruthenium and rhodium”.

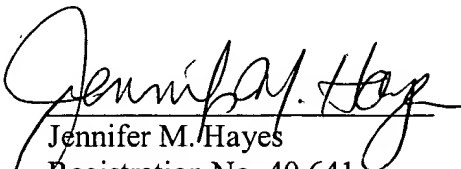
Accordingly, Applicants respectfully request withdrawal of the rejection.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

Amendment Under 37 C.F.R. § 1.116
U.S. Application No. 09/582,495

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,


Jennifer M. Hayes
Registration No. 40,641

SUGHRUE MION, PLLC
2100 Pennsylvania Avenue, N.W.
Washington, D.C. 20037-3213
Telephone: (202) 293-7060
Facsimile: (202) 293-7860
Date: September 3, 2002

APPENDIX
VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

The claims are amended as follows:

4. (Twice Amended) The process for producing a hydrogenated ester according to claim 330, wherein the corresponding hydrogenated ester is a portion or the entirety of the recycled hydrogenated ester which has been produced by the hydrogenation reaction of the unsaturated group-containing ester represented by the general formula (1).

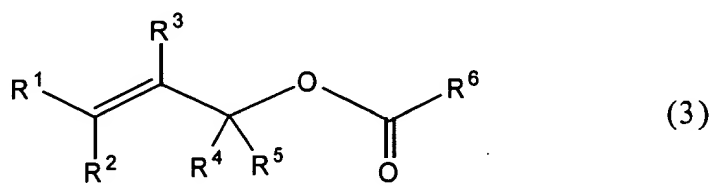
6. (Thrice Amended) The process for producing a hydrogenated ester according to claim 230, wherein the reaction temperature at the initial time of the hydrogenation reaction is in the range of 0°C to 200°C.

7. (Thrice Amended) The process for producing a hydrogenated ester according to claim 230, wherein ~~that~~ the unsaturated group-containing ester represented by the general formula (1) is at least one compound selected from the group consisting of: allyl acetate, crotyl acetate, methallyl acetate, allyl propionate, crotyl propionate, methallyl propionate, vinyl acetate, vinyl propionate, 1,3-butadienyl acetate, and 1,3-butadienyl propionate.

8. (Thrice Amended) The process for producing a hydrogenated ester according to claim 230, wherein the hydrogenating catalyst comprises at least one element selected from the group consisting of Group VIII elements, Group IX elements ~~or~~ and Group X elements in the periodic table.

10. (Thrice Amended) A process for producing a hydrogenated ester by hydrogenating an ~~allyl-type~~ unsaturated group-containing ester represented by a general formula

(1)-(n=1)(3) by using a hydrogenating catalyst so as to produce hydrogenated ester corresponding to the allyl-type unsaturated group-containing ester, wherein the concentration of a carboxylic acid in a raw material containing the unsaturated group-containing allyl-type ester represented by the general formula (1)(3) is 1 wt. % or less:



wherein R¹, R², R³, R⁴ and R⁵ denote an arbitrary alkyl group containing 1-10 carbon atoms, an arbitrary alkenyl group containing 2 - 10 carbon atoms, or a hydrogen atom and may be the same as or different from each other; the alkyl group and alkenyl group may be either straight-chain or branched; R⁶ represents a C1-C10 alkyl group.

32. (Twice Amended) The process for producing a hydrogenated ester according to claim 31, wherein the hydrogenating catalyst ~~selected from at least one metal selected from the group consisting of Group VIII elements, Group IX elements, and Group X elements in the periodic table~~ is comprises at least one of the species selected from the group consisting of palladium, ruthenium and rhodium.

34. (Twice Amended) The process for producing a hydrogenated ester according to claim 33, wherein the hydrogenating catalyst ~~selected from at least one metal selected from the group consisting of Group VIII elements, Group IX elements, and Group X elements in the periodic table~~ is comprises at least one of the species selected from the group consisting of palladium, ruthenium and rhodium.